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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mark C. Nicely

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BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

04/15/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No. 10/668,670	Applicant(s) NICELY ET AL.	
	Examiner M. A. Sager	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008 and 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-23, 25-27, 31-54 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-23, 25-27, 31-54 and 56-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/22/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The information disclosure statement filed Jan 22, 2008 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the listed reference lacks citing its relevant pages or listed reference is illegible. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a). Listed non-patent literature lacks listing relevant pages or is illegible.
2. The information disclosure statement filed Jan 22, 2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. DE 3242890 lacks translation or indication of relevance. Also, RU 17678 includes a translation, although the 1449 states no translation, that has been considered for the translated portion.

Claim Interpretation

3. The invention defined by claim language including ‘a single player’ and regarding first, second and/or third wager or streak round (or similar) fails to preclude multiple wagers placed by a single player over non-simultaneous rounds of play or by multiple players over successive or simultaneous rounds of play at least due to a plurality or multiple players includes a single player

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or stated in the alternative comprising a single player includes and fails to preclude multiple players due to open-ended comprising. Further, currently only claims 7, 21, 45-47 and 57-59 appear to require a plurality [first and second (or third)] of side wagers to be concurrent; however, cited claims fail to preclude wagers from multiple players at least since comprising a single player includes and fails to preclude multiple players or, stated differently a plurality of players includes a single player and present claim language includes tracking of a plurality of players that each make side wager(s) and does not limit to only a single player. Also, claim language does not require first and second (or third) side wager being concurrent (except for cited claims above. The broadest reasonable interpretation of claimed method or apparatus is a counter or mechanism for counting/tracking or displaying status of consecutive events. In essence, the claims pertain to recording and tracking progress of wagers on consecutive events.

Drawings

4. The drawings were received on Jan 14, 2008. These drawings are accepted.

Claim Objections

5. Claim 31 is objected to because of the following informalities: ‘a first a number’ rather than --a first number--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. Claims 1-13, 16-18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Orenstein (‘431). This holding is maintained for cited claims, as amended including a ‘single’ player, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and incorporated herein. Claim interpretation cited above is incorporated

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herein. Orenstein discloses a system and method to manually record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game (abstract, 1:59-2:62, 3:15-4:67, 5:28-6:37, figs. 1-6) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager from a player (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), tracking the number of received consecutive outcomes that are identical to elected type of outcomes for first and second streak (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), where first, second and third wager/streak are representative of first, second and/or third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game or first, second and third wager/streak are representative of a wager from a single player at differing subsequent [not simultaneous] rounds of play. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464,

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1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Orenstein '431 discloses an apparatus (fig 1-6) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (sic, esp. fig. 2-3e) teaching all claimed structure for recording/tracking wagers on consecutive events.

7. Claims 1-13, 15-18, 20-23, 25-27, 38-51, 53-54 and 56-59 are rejected under 35

U.S.C. 102(b) as being anticipated by Orenstein ('885 or '574). This holding is maintained for cited claims, as amended including a 'single' player, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof.

Response to Applicants assertion of patentability is provided below and incorporated herein.

Claim interpretation cited above is incorporated herein. Orenstein '574 incorporates Orenstein

'885 by reference thus discussion follows from Orenstein '885; however, other citations may apply. Orenstein '885 discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 1:43-2:47, 3:18-6:61, figs. 1-8) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager from a player (abstract, 1:43-2:47, figs. 1-8), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, 1:43-2:47, figs. 1-8), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, 1:43-2:47, figs. 1-8), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous by occurrence of use during main rounds of play since players may place

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proposition [such as streak wager] bets prior to start of any game or first, second and third wager/streak are representative of wagers from a single player at differing subsequent [not simultaneous] rounds of play. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Orenstein '885 discloses an apparatus (fig 1-8) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (sic, esp. fig. 1-8, ref 15, 46, 76) teaching all claimed structure for recording/tracking wagers on consecutive events.

8. Claims 1-4, 6-10, 12-13, 15-18, 20-23, 25-27, 31-33, 37-42, 44-48, 50-51, 53-54 and 56-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Forte (5586766). This holding is maintained for cited claims, as amended including a 'single' player, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and incorporated herein. Forte discloses a system and method to electronically record, track and

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monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 3:65-16:36, figs. 1-21) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), where first, second and third wager/streak are representative of a player placing wagers in that are not concurrent or where streak wagers are concurrent they are placed by first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528

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(Fed. Cir. 1990) (emphasis in original). In this case, Forte discloses an apparatus (fig 1-21) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620) teaching all claimed structure for recording/tracking wagers on consecutive events.

9. Claims 1-13, 15-18, 20-23, 25-27, 31-32, 34-35, 37-51, 53-54 and 56-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Feinberg (5851010). This holding is maintained for cited claims, as amended including a 'single' player, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and incorporated herein. Claim interpretation cited above is incorporated herein. Feinberg discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 1:27-41, 2:31-8:49, figs. 1-4) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager from a player (abstract, 3:23-35, fig. 1), receiving an outcome (fig. 1, block 40) and determining whether outcome is same as selected type for first and second streak round (abstract, fig. 1), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, fig. 1-4), where first, second and third wager/streak are representative of first, second and third player wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game or first, second and third wager/streak are

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representative of a wager from a single player at differing subsequent [not simultaneous] rounds of play. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Feinberg discloses an apparatus (fig 1-4) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (abstract, figs. 1-4) teaching all claimed structure for recording/tracking wagers on consecutive events.

Claim Rejections - 35 USC § 103

10. Claims 14, 34-35 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg. Feinberg discloses invention including tracking consecutive [streak] events (figs 1-4) on a game table (figs. 1-4, esp. 1 and 3) or by gaming machine that would be done electronically or electromechanically (fig. 1 and 3) which clearly fig 3 depicts a graphical image of progress, but does not particularly describe a graph or bar graph as claimed. Although the representation of progress of consecutive events taught by Feinberg is not a graph or bar graph, as claimed, the display taught by Feinberg provides progress of consecutive events such as streak rounds of

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claimed invention in that the claimed graph or bar graph fails to patentably distinguish. A graph or bar graph provides an easy visual indication of state of progress and thus it would have been obvious to an artisan at a time prior to add a graph, bar graph, chart or pie chart to Feinberg so as to provide an easy visual indication of progress of streak round/wager.

11. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg. Feinberg lacks chart and pie chart. Although the representation of progress of consecutive events taught by Feinberg is not a chart or pie chart, as claimed, the display taught by Feinberg provides progress of consecutive events such as streak rounds of claimed invention in that the claimed chart or pie chart fails to patentably distinguish. A chart or pie chart provides an easy visual indication of state of progress and thus would have been obvious to an artisan at a time prior to the invention to add chart or pie chart to Feinberg so as to provide an easy visual indication of progress of streak round/wager.

Response to Arguments

12. Applicant's arguments filed 1/14/08 have been fully considered but they are not persuasive. In response to Applicants argument(s) regarding patentability, the examiner disagrees that present claimed invention is limited to *only* a single player placing multiple streak round wagers. Although the claims have been amended to claim a single player, as stated above, present claim language fails to preclude a single player placing multiple non-concurrent side wagers or multiple players placing a side wager that are concurrent with one another as rendering claimed invention taught by cited art at least due to failing to require *only* a [single] player and failing to differentiate first and second (or third) side wagers as being simultaneous. Also, Applicant did not refute findings of fact regarding prior art in prior action that have been

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maintained herein with respect to claimed manner of use-like claims for tracking side [proposition] wagers in game in that manner of players placing side wagers in prior art consecutive event systems by either a single player over non-concurrent rounds of play or by multiple players over either concurrent or non-concurrent rounds of play. As stated above in claim interpretation, currently only claims 7, 21, 45-47 and 57-59 appear to require the plurality [first and second (or third)] of side wagers to be concurrent but these claims similarly fail to preclude the side wagers being placed by multiple different players concurrently which can occur at play on table game or electronic game. Also, this is clarifying how breadth of present claimed invention is taught by cited references. Further, the different references are applied due to different forms of presentation [display] and tracking [manual, electronic, electro-mechanical] that appear to be included by present claimed invention. Further, it is reiterated as cited in holdings above that claiming the manner of use [single player placing side wager(s)] of structure fails to patentably distinguish over references teaching the structure; especially, in light that claimed structure cannot differentiate who is using in that there is no identification of player required presently in the placement of wager, but merely that a plurality or capability of a plurality of side wagers being recorded [concurrent or non-concurrent] and progress tracked.

Conclusion

13. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

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See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. Sager/
Primary Examiner, Art Unit 3714